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EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,212

Applicant(s)

MAMDANI ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,13-42,44-48 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,13-42,44-48 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>15</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 13, 28, 31, 34, and 44-47 have been amended.
- Claims 11, 12, 43, 49, 50, 51, 53, 54, and 55 are canceled.
- Claims 1-10, 13-42, 44-48, and 52 have been considered.

2. It should be noted that the current rejection has been the result of the opening prosecution based on the submission of additional prior art by the applicant, which inadvertently was not entered before the time that the notice of allowance was mailed (on 17 December 2003). Applicant did submit the newfound art in a timely manner (as an IDS on 3 November 2003), though for unseen circumstances the examiner did not had the opportunity to review the submitted art until such time that it was reviewed in publishing, which caused the prosecution of the application to be re-opened and the withdrawal of the allowance. The issue fee at this point could be re-funded to the applicant or held in credit until such time that the application has been granted a new notice of allowance.

Response to Arguments

3. Applicant's arguments filed 18 April 2003 have been fully considered but they are not persuasive as well as but they are moot in view of the new ground(s) of rejection.

4. Examiner withdraws rejection of claims 20, 21, 28, 30-33, and 45 under 35 U.S.C 112-second paragraphs due to corrections and amendments by the applicant.

5. In addition the arguments put forward by the applicant in regards to the interview, conducted in person by attorney Thomas F. Bergert on 25 August 2004, has been entered and considered.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 3, 4, 5, 13, 34, 38-42, and 44-47 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0004746 to John B. Ferber.
8. As per claims 1, 5, and 34, Ferber discloses a method for facilitating a wireless transaction, comprising:
- receiving, by a transaction management system, a transaction request from a transaction requester (See Ferber figures 1 and 4, paragraphs [0028]-[0030]);
 - communicating a first transaction code to a wireless communication device (See Ferber figures 1 and 4, paragraphs [0008]-[0010], [0021], [0023], [0028]-[0030]);
 - displaying the first transaction code on a visual display of the wireless communication device (See Ferber figures 1 and 4, paragraphs [0009], [0025], [0030]);
 - optically scanning the first transaction code from the visual display (See Ferber figures 1 and 4, paragraphs [0009], [0025], [0030]); and
 - receiving, by the transaction management system, a decoded representation of the first transaction code in response to optically scanning the first transaction code (See Ferber figures 1 and 4, paragraphs [0008]-[0010], [0021], [0023], [0028]-[0030]);
 - verifying an identity of the transaction requester (See Ferber figures 1 and 4, paragraphs [0008]-[0010], [0021], [0023], [0028]-[0030]).
9. As per claims 2, Ferber discloses the method of claim 1 wherein communicating the first transaction code includes communicating a first optically scannable transaction code (See Ferber figures 1 and 4, paragraphs [0008]-[0010], [0021], [0023], [0028]-[0030]).

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10. As per claims 3, Ferber discloses the method of claim 2 wherein communicating the optically scannable first transaction code includes communicating a first transaction barcode (See Ferber paragraphs [0009] and [0025]).

11. As per claims 4, Ferber discloses the method of claim 1 wherein communicating the first transaction code includes communicating the first transaction code from the transaction management system (See Ferber figures 1 and 4, paragraphs [0008]-[0010], [0021], [0023], [0028]-[0030]).

12. As per claims 13, Ferber discloses all the limitations of claim 1, further;

Ferber discloses receiving, by the transaction management system, a first fulfillment verification after optically scanning the first transaction code (See Ferber figures 1 and 4, [0009], [0025], [0030]).

13. As per claims 38, Ferber discloses the system of claim 34, wherein the transaction management system is coupled to a telecommunication network system for enabling communication with the wireless communication device (See Ferber figure 1).

14. As per claims 39, Ferber discloses the system of claim 38, wherein the transaction management system is coupled to the telecommunication network through a computer network system (See Ferber figure 1 and paragraphs [0021], [0022]).

15. As per claims 40, Ferber discloses the system of claim 34, wherein the transaction management system is coupled to a wireless data network system for enabling communication with the wireless communication device (See Ferber figure 1 and paragraphs [0021], [0022]).

16. As per claims 41, Ferber discloses the system of claim 40, wherein the transaction management system is coupled to the wireless data network system through a computer network system (See Ferber figure 1 and paragraphs [0021], [0022]).

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17. As per claims 42, Ferber discloses the system of claim 41, wherein the wireless data network system includes a wireless local area network system (See Ferber figure 1 and [0021], [0022]).

18. As per claims 44, Ferber discloses the system of claim 34 wherein the transaction fulfillment system includes a code-scanning device (See Ferber paragraphs [0009], [0025]).

19. As per claims 45, Ferber discloses the system of claim 44 wherein the code-scanning device includes a bar code reader (See Ferber paragraphs [0009], [0025]).

20. As per claims 46, Ferber discloses the system of claim 34 wherein the transaction fulfillment system is capable of decoding the transaction code in response to optically scanning the transaction code (See Ferber paragraphs [0025], [0030]).

21. As per claims 47, Ferber discloses the system of claim 34 wherein the transaction fulfillment system and the wireless communication device each include a radio transceiver for enabling communication directly between the wireless communication device and the transaction fulfillment system (See Ferber figure 1 and paragraphs [0021], [0022]).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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23. Claims 6-10, 14, 16-18, and 20-21, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0004746 to John B. Ferber in view of U.S. Patent No. 5,590,038 to Satyan G. Pitroda.

24. As per claims 6-9 and 35-37, Ferber disclose all the limitations of claims 1 and 34, further;

Ferber does not explicitly disclose verifying the identity of the transaction requester includes authenticating a transaction requester through the use of a speech services module for audibly verifying the identity of the requester by comparing voiceprints. Examiner takes Official Notice that verifying the identity of transaction requester is notoriously well known in the business art. For example, Pitroda discloses an electronic transaction system and method for conducting electronic transactions and clearly discloses method for verification of the identity of a transaction requester by displaying signatures or other types of identifications such as photographs, fingerprints or voice prints (See Pitroda column 12, lines 54-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to modify the Ferber's teachings and verify the identity of the transaction requester for obvious reasons such as ensuring that the requester is actually the person they claims to be and are authorized to carry out the transaction.

25. As per claims 10, 14, 16-18, and 20-21, Ferber discloses all the limitations of claim 6, further; Ferber discloses displaying the first transaction code on a visual display of the wireless communication device; and optically scanning the first transaction code from the visual display (See Ferber figures 1 and 4, paragraphs [0008]-[0010], [0021], [0023], [0028]-[0030]).

26. Claims 15, 19, 22-33 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0004746 to John B. Ferber.

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27. As per claims 15, 22-26, and 52, Ferber discloses a method for facilitating a wireless transaction, comprising:

- receiving, by a transaction management system, a transaction request from a transaction requester (See Ferber figures 1 and 4, paragraphs [0028]-[0030]);
- communicating a first transaction code to a wireless communication device (See Ferber figures 1 and 4, paragraphs [0008]-[0010], [0021], [0023], [0028]-[0030]);
- displaying the first transaction code on a visual display of the wireless communication device (See Ferber figures 1 and 4, paragraphs [0009], [0025], [0030]);
- optically scanning the first transaction code from the visual display (See Ferber figures 1 and 4, paragraphs [0009], [0025], [0030]); and
- receiving, by the transaction management system, a decoded representation of the first transaction code in response to optically scanning the first transaction code (See Ferber figures 1 and 4, paragraphs [0008]-[0010], [0021], [0023], [0028]-[0030]);
- verifying an identity of the transaction requester (See Ferber figures 1 and 4, paragraphs [0008]-[0010], [0021], [0023], [0028]-[0030]).
- optically scanning the second transaction code from a visual display of the wireless communication device (See Ferber figures 1 and 4, paragraphs [0008]-[0010], [0021], [0023], [0028]-[0030]).

What Ferber fails to specifically and explicitly disclose communicating a second transaction code to the wireless communication device after receiving the first fulfillment verification. Examiner submits that forwarding or communicating a second verification message or transaction code in a transaction system would have been obvious to one having ordinary skill in the art at the time of applicants claimed invention. It also would have been obvious to one having ordinary skill in the art to communicate more than one message or transaction code in any transaction system since it has been held that mere duplication of essential working parts of a device or duplication of steps involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to modify the Ferbe's teachings to send a second message for providing a better tracking of the transaction fulfillment in relation to keeping records of such transaction.

28. As per claims 19 and 27, Ferber discloses all the limitations of claims 1 and 22, further;

Ferber is not explicit on verifying the transaction code in response to scanning the transaction code, however, examiner submits that one having ordinary skill in the art the at the time of applicant's invention would have recognized that this is a well known step when redeeming coupons. For example, at a minimum, an expiration date associated with the coupon code would have been verified.

29. As per claims 28-33, Ferber discloses all the limitations of claim 27, further;

What Ferber fails to specifically and explicitly disclose communicating a second transaction code to the wireless communication device after receiving the first fulfillment verification. Examiner submits that forwarding or communicating a second verification message or transaction code in a transaction system would have been obvious to one having ordinary skill in the art at the time of applicants claimed invention. It also would have been obvious to one having ordinary skill in the art to communicate more than one message or transaction code in any transaction system since it has been held that mere duplication of essential working parts of a device or duplication of steps involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to modify the Ferbe's teachings to send a second message for providing a better tracking of the transaction fulfillment in relation to keeping records of such transaction.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the

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response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9 AM to 5:00 PM.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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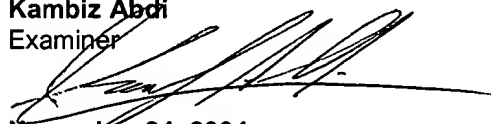
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

Kambiz Abdi
Examiner



November 24, 2004